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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,095	06/29/2001	Dwip N. Banerjee	AUS920010447US1	6698
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380				
EXAMINER BAYAT, BRADLEY B				
ART UNIT		PAPER NUMBER		
3621				

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,095

Applicant(s)

BANERJEE ET AL.

Examiner

Bradley Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Status of Claims

Applicant has amended claims 1, 4, 5, 9, 16, 17, 20, 21, 25 and 32-35 in the amendment filed on March 23, 2004. Therefore, claims 1-35 are again presented for examination on the merits.

Response to Arguments

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (hereinafter Ginter, 5,910,987 A1) in view of Christiano (5,671,412).

1. As per claims 1, 4, 33 and 34 Ginter discloses a method of digital rights management, comprising: associating a field with an electronic property, wherein the first field identifies a current owner of the electronic property (column 144, line 12 – column 145 line 49); and wherein access control software allows access to the property only upon verification that a user satisfies specified requirements for access (columns 82-83; column 135, lines 20-34). Ginter

Art Unit: 3621

does not explicitly disclose including a field wherein a list of prior owners is compiled.

Christiano, however, teaches a license management system for software application, wherein software ownership history is compiled in addition to several identifying fields with regards to various aspects of digital ownership of the property (column 3, line 10-column 5, lines 18). One of ordinary skill at the time of the claimed invention would recognize that it would be obvious to record ownerships rights to electronic property, because unlike tangible property, electronic property can be easily transferred between multiple parties and in order to protect the rights of the current owner, it would be useful to keep a record of all owners to ensure that the proper owner is accessing the property, as per teachings of Christiano (columns 6-7; figures 1-8 and associated text).

As per the following claims, Ginter further discloses:

2. The method according to claim 1, wherein the access control software restricts use of the electronic property to the person identified as the current owner (column 83, line 63 – column 84, line 67).

3. The method according to claim 1, further comprising notifying the electronic property's manufacturer in case of property rights violations (column 42, lines 4-16; see also section describing certificates).

5. The method according to claim 4, further comprising allowing access to the property by the subsequent owner only after the current owner has electronically signed an entry identifying the

Art Unit: 3621

subsequent owner (columns 19, 21-22).

6. The method according to claim 4, further comprising storing the information associated with the ownership transfer in a backup server (columns 17-18).

7. The method according to claim 4, further comprising sending notice of the transfer of ownership to the electronic property's manufacturer (columns 286-289).

8. The method according to claim 4, wherein the subsequent owner inherits the same access privileges as the current owner (column 57, 25-34).

9. The method according to claim 1, further comprising: if use of the electronic property is temporarily loaned by the current owner to a borrower: associating a third field with the electronic property, wherein the third field identifies the current borrower of the electronic property and designates the duration of the time period of the loan; and wherein access control software allows borrower access to the property only during the duration of the loan period (columns 55-59).

10. The method according to claim 9, wherein access control hardware restricts access to the electronic property to the person identified as borrower (columns 55-60).

11. The method according to claim 9, wherein the current owner cannot access the electronic

property during the duration of the loan period (columns 55-60).

12. The method according to claim 9, further comprising storing the information about the loan in a backup server (column 2-8see rights operating system in summary).

13. The method according to claim 9, wherein the current owner may simultaneously loan the electronic property to multiple borrowers (columns 55-61; see access control and rules and controls).

14. The method according to claim 9, further comprising sending notice of the loan to the electronic property's manufacturer (columns 83-84; see certificates as above).

15. The method according to claim 9, wherein the borrower acquires a specified portion of the owner's access privileges (columns 55-61; see access control and rules and controls).

16. The method according to claim 1, wherein the property title is stored in the same file with the digital property itself (figure 17 and associated text).

Claims 17-32 directed to a computer readable medium are rejected as above.

35. The system according to claim 33, further comprising: if use of the electronic property is temporarily loaned by the current owner to a borrower: a third register which associates a third

Art Unit: 3621

field with the electronic property, wherein the third field identifies the current borrower of the electronic property and designates the duration of the time period of the loan; and wherein access control software allows borrower access to the property only during the duration of the loan period (see rejection under first group; columns 23-49).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3621

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Patent No. 6,047,242 to Benson.
- Patent No. 6,411,941 to Mullor et al.
- Patent No. 6,574,612 to Baratti et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb



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